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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the reissue application of:

Don A. Perry and H. Earl Wright

Title: Touch Enhancing Pad

Serial No. 07/337,253

Filed April 13, 1989

91-2492

Art Unit 335

Examiner: R. Shay

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R. Shay
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#12/
Appeal
Brief

APPEAL BRIEF

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GROUP 350

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the Final Rejection dated
October 17, 1990.

STATUS OF CLAIMS

Claims 1 to 12 are rejected and are on appeal. Claim
13 was previously cancelled.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the Final
Rejection.

SUMMARY OF THE INVENTION

The invention is a pad which enhances the sense of
touch when placed between the fingertips of the user and the
object being touched. The pad comprises an enclosure of a
relatively thin, strong, pliable, and elastic material with

a liquid lubricant sealed within. The properties of the enclosure and the lubricant are described in detail below with references to the page and line number of the specification. The pad is manufactured and sold by Inventive Products, Inc., the assignee of the invention and of this application, under the trademark SENSOR PAD®. The pad has been marketed primarily as an aid for women in performing breast self-examinations. Since its commercial introduction in April, 1988, over 200,000 pads have been manufactured and sold.

The pad's enclosure has a wall thickness of about 0.005 to 0.020 inches (p. 3, lines 31-32) and a modulus of elasticity at 300 percent elongation of less than about 1,500 psi (p. 3, lines 40-42). It has a tensile strength of greater than about 3,000 psi (p. 3, lines 29-30) and an ultimate elongation of greater than about 400 percent (p. 3, lines 46-48).

In the first embodiment of the invention recited in Claims 1 to 11, the enclosure is formed of a single piece of material. In the second embodiment of the invention recited in Claim 12, the enclosure is formed from two pieces of material.

The liquid lubricant sealed inside the enclosure has sufficient lubricity to reduce the coefficient of kinetic friction between the interior walls of the enclosure by at least about 60 percent (p. 4, lines 26-28). This reduction of friction enables the top wall of the enclosure to move freely with the fingertips while the bottom wall remains stationary over the object being touched (p. 3, lines 12-15). The lubricant has substantial inertness towards the enclosure (p. 4, lines 35-37) and has a sufficiently-high resistance to mass transfer through the enclosure so that

the amount of lubricant inside the enclosure remains substantially constant over time (p. 4, lines 28-32). The lubricant is present in an amount sufficient to fully coat the interior of the enclosure and yet small enough so that the enclosure can be flattened with at least about 75 percent of the surface area of one wall in contact with the other wall with only a minimum layer of lubricant between the walls (p. 4, lines 41-48).

ISSUES

Is the reissue declaration defective because the discovery of the error was made as a result of commercial activity which occurred after the original patent had issued?

Is Claim 12 unpatentable under 35 U.S.C. §103 over Paschal, U.S. Pat. No. 2,694,396, issued Nov. 16, 1954, in view of Beck, German Pat. No. 645,391, effective Mar. 30, 1932?

Is an additional drawing required to illustrate the second embodiment of the pad formed from two pieces of material?

GROUPING OF CLAIMS

The rejection based on the reissue declaration applies to all the claims.

The obviousness rejection applies only to Claim 12.

ARGUMENT

1. The Reissue Declaration

Pursuant to 35 U.S.C. §251, a patent may be reissued if it is partly inoperative because the patentee erred by claiming less than he had a right to claim. The Examiner takes the position that reissue is not available in this case because no "error" occurred. The Applicants submit that amending Claim 1 during prosecution of the original patent (U.S. Pat. No. 4,657,021, hereafter the "Patent") to recite that the enclosure of the touch enhancing pad is formed of a single piece of material was an "error" within the meaning of the statute.

A very brief review of the prosecution of the Patent, as detailed in the Amended Reissue Declaration, may be helpful. At the time the original application was filed, the Applicants believed that the preferred enclosure for the touch enhancing pad was a single piece of natural latex rubber. Latex rubber possesses unique properties of strength, pliability, and elasticity which the Applicants discovered were essential for touch enhancement. However, latex rubber cannot be effectively heat sealed or glued. Therefore, an enclosure made from two pieces of latex rubber would require a bulky, physical seal of some type. Various synthetic materials are heat sealable, but none had been found with the properties necessary for touch enhancement. Accordingly, the original specification stated, "Although a plurality of pieces of material can be joined together to form the enclosure, it is preferred that the enclosure be formed of a single piece of material because the presence of a seam of any type tends to interfere with the movement of

the pad during use." Original Claim 1 did not specify the number of pieces of material in the enclosure.

During prosecution of the Patent, the Examiner rejected Claim 1 as unpatentable over Paschal and an article by Michael Madden et al. about model female breasts, in view of a number of secondary references. The recitation of the single piece of material was added to Claim 1 as an additional means of distinguishing the claims from the primary references. The application was allowed and the Patent issued on April 14, 1987.

Sales of the SENSOR PAD touch enhancing pad were begun in early 1988. The original pads had enclosures of a single piece of natural latex rubber. Shortly thereafter, Inventive Products, Inc. became aware of a synthetic polyurethane film with properties of strength, pliability, and elasticity similar to those of latex rubber and within the ranges recited in the claims of the Patent. Unlike latex rubber, this polyurethane film could be heat-sealed. For a number of reasons, Inventive Products, Inc. decided in late 1988 to change the SENSOR PAD's enclosure from one piece of latex rubber to two pieces of heat-sealed polyurethane. With the change to a two-piece enclosure, the Applicants found that the claims in the Patent could be interpreted as not literally reading upon the commercial product. This broadened reissue application was filed as a result. The only difference between the pending claims and the claims in the Patent is Claim 12.

The Examiner's position that no "error" occurred during prosecution appears to be based upon two separate arguments. First, the Examiner appears to take the position that the Applicants did not claim less than they had a right to claim. This position was discussed with the Applicants' attorney during a telephonic interview on January 15, 1991.

In other words, the Examiner alleges that the claims in the Patent are as broad as the prior art permits and Claim 12 is not patentable. This argument is addressed in the following section on the patentability of Claim 12.

The second argument advanced by the Examiner is that there was no "error," and hence the reissue declaration is defective, because the discovery of the error occurred as a result of commercial activity which occurred after the Patent issued. This position is set forth on page 2 of the Final Rejection. The Applicants submit that the critical consideration in reissue is whether an error occurred without deceptive intent. How that error is finally discovered is of little or no importance. In fact, commercial development after the issuance of a patent is often the reason an error is discovered.

A good example of this type of situation is In re Wilder, 736 F. 2d 1516 (Fed. Cir. 1984), which concerned a patent on a dictating machine. Shortly after the patent issued, the assignee of the patent began selling a new dictating machine known as the "Thought Master II" machine. After several months had passed, one of the inventors met with the assignee's patent attorney and asked him to investigate whether the claims of the patent read upon the new machine. The attorney discovered that the claims did not read upon the machine. Upon further study, the attorney concluded that the claims were narrower than the prior art required. A broadened reissue application was filed with new claims reading upon the new machine. The Court of Appeals for the Federal Circuit noted that the attorney had failed to appreciate the full scope of the invention and this error was discovered "after commercialization of the invention and issuance of the patent" and held that these facts satisfied the requirements of 35 U.S.C. §251.

A similar situation occurred in Application of Wadlinger, 496 F. 2d 1200 (CCPA 1974), where a patent issued with claims directed to a crystalline zeolite catalyst composition. After the patent issued, it was discovered that the catalyst performed surprisingly well in certain hydrocarbon reactions. See note 2. A reissue application was then filed to add process claims. The Court held that these facts satisfied the requirements of 35 U.S.C. §251.

2. Patentability Of Claim 12

The Examiner rejected Claim 12 under 35 U.S.C. §103 as being unpatentable over Paschal in view of Beck. Paschal discloses and claims a massaging device consisting of two pieces of satin fabric. In column 2, Paschal mentions a second embodiment of the massaging device consisting of "a sheet formed of flexible plastic material or any other suitable flexible material which is impervious to liquid and a second sheet of the same or like material fused or seamed together...near the edges thereof and having sealed in the interior thereof a lubricant." Beck discloses a massage safety cushion consisting of rubber filled with a lubricant. The cushion is intended for use with a separate "massaging element." Suitable "massaging elements" are rubber pads provided with ribs or projecting pins, bags filled with balls, hollow-walled air-filled bags having ribs on the exterior walls, and also the hands themselves. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to have constructed a Paschal two-piece pad using the natural latex rubber available in 1985 for use as a massaging pad and that such a pad would possess the properties specified in Claim 12. The Applicants traverse this rejection.

A similar fact situation was addressed by the Court of Appeals for the Federal Circuit in In re Wright, 848 F. 2d 1216 (Fed. Cir. 1988). At page 5 of the Final Rejection, the Examiner states that this case is under appeal. The Applicants have been unable to find any basis for the Examiner's statement. In fact, the Wright decision was endorsed in In re Dillon, 892 F. 2d 1554, 1567 (Fed. Cir. 1989), and the Applicants believe the case is precedential. The invention in Wright was a carpenter's level which measures greater changes of pitch before the bubble reaches the end of the vial. The two features responsible for this property are a barrel-shaped vial and a core pin running through the vial. The Patent and Trademark Office had rejected the claims as being unpatentable over Vaida in view of Bishop. The Vaida reference taught that a barrel-shaped vial measured greater changes of pitch than a cylindrical vial. The Bishop reference taught that a core pin running through a cylindrical vial improved the visibility of the bubble. The PTO's position was that it would have been obvious to combine Vaida and Bishop to provide a level having a bubble which was easier to see and that such a level would be within the claims of Wright.

The Court of Appeals first reviewed the law of obviousness. It stated that "the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working" and that "[f]actors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness" Id. at 1219.

The Court then noted that "[n]o reference shows or suggests the properties and results of Wright's claimed

structure and that "[i]t is not pertinent whether Wright's new structure also has the prior art attribute of increased visibility of the bubble, for that is not his invention. Id. at 1220. The Court went on to reverse the rejection of the claims.

The Examiner is attempting to do the same thing in this case as was mistakenly done by the PTO in Wright. Paschal discloses a massage pad made of two pieces of plastic. Beck discloses a massage cushion of rubber. If the Applicants' invention were merely a rubber massage pad, it might be appropriate to combine the references as the Examiner has done. But the Applicants' invention is not merely a massage pad and it is not pertinent that the apparatus of Claim 12 would undoubtedly function as a massage pad. The Applicants' invention is, instead, a touch enhancing pad and nothing in Paschal or Beck suggests such properties.

The Wright decision suggests that there is a threshold requirement for a determination of obviousness that the prior art contain a suggestion or teaching of a solution to the problem that the applicant faced. Because the prior art does not even address the problem of touch enhancement, the threshold requirement is not met here.

The Wright court stated that unexpected results are a consideration in the determination of obviousness. The touch enhancing properties of the Applicants' invention were discovered by accident and one literally has to handle the touch enhancing pad to fully comprehend its properties. As noted above, Paschal and Beck never mention the sense of touch. The prior art that does address the sense of touch teaches that the sense will be diminished if even a very thin layer of material is placed between the skin and the object to be touched, and that the sense will be further diminished if the thickness of the layer increases or if the

number of layers increases. Nothing in the prior art suggests any method of touch enhancement and certainly does not suggest that the use of two layers of material could possibly enhance the sense of touch.

In the Wright case, there appeared to be no question that combining the two references would, in fact, produce Wright's invention. (The combination was improper only because there was no suggestion that the combination would solve the problem). However, in this case, even if Paschal and Beck were combined, the Applicants' invention is not produced. This follows from the fact that neither the "plastic" materials available to Paschal nor the "rubber" materials available to Beck possess the physical properties specified in Claim 12 as being necessary for touch enhancement. This fact is set forth in the two affidavits of Professor Thaddeus Ichniowski attached to the Amendment filed April 26, 1990. The Examiner argues that a 1951 disclosure of "plastics" and a 1932 disclosure of "rubber" teaches a person skilled in the art as of 1985 to use currently-available materials fitting such descriptions. Therefore, according to the Examiner, it is irrelevant what materials were available to Paschal and Beck. The Applicants submit that the information in Paschal and Beck must be considered as of their dates. Neither Mr. Paschal nor Mr. Beck possessed crystal balls to tell them what properties the materials bearing these names would have decades later. As noted by the court in Pfizer, Inc. v. International Rectifier Corp., 545 F. Supp. 486, 522 (C.D. Calif. 1980), aff'd 685 F. 2d 357, cert. denied 459 U.S. 1172, "The information conveyed by prior art is crystallized as of the date it is made public and the crystals cannot be corrected or altered to convey

information or facts later acquired by others skilled in the art." (Emphasis in the original).

Also attached to the Amendment dated April 26, 1990 was an affidavit of Grant Wright, the president of Inventive Products, Inc., setting forth a number of "secondary considerations," including commercial success and the recognition of the Applicants as Finalists in the 1989 Inventor of the Year Award sponsored by Intellectual Property Owners, Inc. The Examiner stated only that secondary considerations do not make the claim allowable when there is a "solid rejection based on art." The Applicants submit that the secondary considerations must be considered. As stated by the Court of Appeals for the Federal Circuit, "If, however, a patent applicant properly presents evidence relating to these secondary considerations, the [Board of Patent Appeals and Interferences] must always consider such evidence in connection with the determination of obviousness." In Re Sernaker, 702 F. 2d 989, 996 (Fed. Cir. 1983).

Finally, the Applicants note that a number of foreign patent offices have allowed patent claims on the touch enhancing pad without a recitation that the enclosure is formed from a single piece of material. See, for example, Canadian Pat. No. 1,238,253, issued June 21, 1988; Australian Pat. No. 591,116, issued March 30, 1990; and European Pat. Application No. 86-302881.7, now entering into force in ten European countries.

3. Additional Drawing

The Examiner objected to the drawings under 37 C.F.R. §1.83(a) because they do not show an enclosure formed from two pieces of material, as recited in Claim 12. The

drawings show only the embodiment of the touch enhancing pad described in Claim 1 which is formed of a single piece of material. The Applicants traverse this objection.

The Examiner does not suggest that an additional drawing is necessary for the understanding of the subject matter in Claim 12. The two-piece pad is simply another embodiment of the invention and it is well established that it is not necessary to illustrate every embodiment of the invention. Anthony Company v. Perfection Steel Body Company, 315 F. 2d 138, 140 (6th Cir. 1963).

CONCLUSION

Reissue is available in this case because it was an error to limit the claims in the Patent to a touch enhancing pad having a one-piece enclosure.

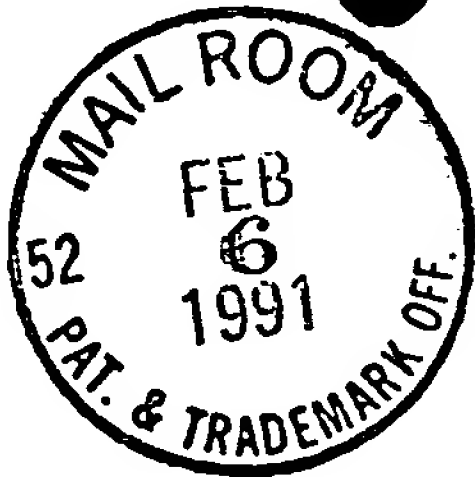
Claim 12, which is directed to a touch enhancing pad having a two-piece enclosure, is not rendered obvious by Paschal and Beck. The pad recited in Claim 12 has touch enhancing properties not suggested by either reference. Furthermore, the physical characteristics of the enclosure which are necessary for touch enhancement were not present in the materials available to Paschal and Beck.

Additional drawings are not needed to understand the invention.

The Applicants request the Board of Patent Appeals and Interferences to reverse the Final Rejection of the Examiner and to allow Claims 1 to 12.

Respectfully submitted,

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CERTIFICATE OF MAILING

PHILIP L. BATEMAN certifies that three copies of this Appeal Brief are deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231, on February L , 1991.

Philip L. Bateman
PHILIP L. BATEMAN